THE ENTRY OF AMENDMENTS

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It is the well settled practice of the Patent Office to permit an inventor to amend his application under certain restrictions, to supply omissions and defects and correct informalities in the papers that have been filed, and to otherwise revise the application to secure for him the invention to which he is legally entitled. But in permitting amendments to be made, due regard must be had for the rights of the public in general and the rights of rival inventors.

UNSIGNED OR IMPROPERLY SIGNED AMENDMENTS

which are to be returned for signature should be forwarded to the Chief Clerk of the Patent Office with a memorandum giving the name and address of the attorney, date of the last office action in the case, and a statement as to why the paper is to be returned. The Chief Clerk will cancel the receiving stamp and conduct the correspondence incident to the return of the papers. If there is not sufficient time for the return of the amendment for signature before the expiration of the time allowed by law within which to take proper action, the examiner will endorse it on the file wrapper, but will not enter the amendment, and will notify the applicant of the status of the case. The informal amendment may be useful in determining the question of abandonment of the application.

In all cases where papers are returned to applicants for any reason it is advisable that the clerk place a pencil memorandum in the file for future reference. The record in every case should be so complete that any person

taking up the case at any time can understand the status or condition of the case without making any inquiries.

If an amendment is signed by rubber stamp, it should not be accepted. Ex parte Minehan, 134 O. G., 1298 (1908). Acceptance of amendments so signed would open the door for grave irregularities. Amendments should be signed by the applicant or his attorney with pen and ink or their equivalent. An amendment with a stamped signature should be treated as an unsigned or improperly signed paper.

PERMANENT INK.

Amendments must be written in permanent ink. Ex parte Burns, 101 O. G., 661 (1902). In 1880, July 30th, Commissioner Marble issued the following order, No. 32:

> All applications, communications, and other instruments in writing or print, which should constitute a permanent record in the office, must be prepared with a substantially permanent ink. Analin and other perishable inks will not be accepted.

It appears that a permanent ink must have a foundation of lampblack or carbon. The tests given in Ex parte Blaubach, 84 O. G., 1732 (1898), and used in other Executive Departments are two in number—first the application of Labarraque's solution followed by a saturated solution of oxalic acid, and second, the application of a 10 per cent solution of nitric acid. Ex parte Ritter, 57 O. G., 1883 (1891) is another decision that bears on the question of fugitive inks. See also Rule 30.

AMENDMENTS IN GENERAL.

Where an amendment to an application is received more than a year after the date of the last office action, it is indorsed on the file wrapper of the application, but is not formally entered, and the examiner immediately notifies the applicant that the amendment was not filed within the statutory period, and therefore can not be entered. Order 1854.

When an Associate Attorney is prosecuting a case, and the Principal Attorney files an amendment over his own signature, it must be entered and acted upon, if it is otherwise a proper amendment. The practice of filing amendments by both the principal and associate is discouraged. Ex parte Eggan, 172 O. G., 1091 (1911). This decision also states with whom the correspondence is held when there are several attorneys in the case.

A substitute specification is objectionable and in general should not be filed unless required by the office in view of the number or nature of the amendments to the original specification. No general rule can be given as each case must be decided upon its own merits. Ex parte Orewiler, 170 O. G., 481 (1911).

Where an inventor files his own case, and at the suggestion of the office employs an attorney a new specification is admitted. Ex parte Clifford, 193 O. G., 511 (1913). This is not an exception to the general practice, but is based upon the presumption that the conditions are such as to necessitate a new specification.

It is the well-settled practice of the office that an amendment can not be entered in part. To enter an amendment so far as responsive and to refuse to enter the remainder thereof, would lead to endless confusion. As an example, where after final rejection an amendment is presented canceling the finally rejected claims and presenting certain new claims without a verified showing, the amendment should not be entered. Ex parte Hodge, 173 O. G., 1079 (1911).

An amendment is presented in which the last claim is canceled by a line drawn through it with a pen without anything to indicate who canceled it. The amendment is informal but should be entered and applicant should be required to cancel the claim by the usual amendment. In like manner, pencil interlineations which apparently are intended to be a part of the specification should be called to applicant's attention in order that they may be erased or entered in the case upon proper authorization.

Where applicant's instructions to amend are erroneous, but it is clear what his intentions are, the amendment should be properly entered and applicant, in the next office letter, should be informed definitely what has been done.

Where a case is not closed against further prosecution and an amendment is received that is fully responsive and also contains additional matter that is not responsive, it is the practice to enter the entire amendment, give action on the responsive part, and require the cancellation of the part that is not responsive.

Claims which necessitate the requirement of division, if presented in an amendment, should be entered and division required. Claims presenting a new species other than that elected should be entered and applicant should be required to cancel them. Ex parte Selle, 110 O. G., 1728 (1904).

Where the examiner suggests claims to an application for the purpose of interference under Rule 96, and sets a time within which to make them, and the applicant does not make the claims until the other interfering application has become a patent, it was held that the amendment should be entered, and the claim considered in order to give applicant an opportunity for appeal. Ex parte Swift, 111 O. G., 2494 (1904).

DELAYED APPLICATIONS.

It is a great injustice to the public and other inventors to permit an applicant to prosecute his application indefinitely and keep his invention from the public while the art is growing up and passing by his invention. To then allow a patent to issue with claims covering the art is unjust and inequitable to the public and especially to other inventors who have developed the art. The practice announced in Ex parte Miller, 139 O. G., 730, and Ex parte Perry, 140 O. G., 1001, is designed to remedy this evil by closing the prosecution of applications before the office, when they have been pending for a long time, or when an issue has been reached.

The policy of the Patent Office, as gleaned from the Commissioner's report, 199 O. G., 939, and a later report in the Scientific American, August 1, 1914, is to reduce the time during which applications may pend in the office. An order is now in force which requires amendments to cases which have been pending five years or more, to be called to the personal attention of the Commissioner before being entered. This time is to be

gradually reduced until cases which have been pending more than two years will probably be included in this order. An investigation instituted by Commissioner Ewing last June disclosed the fact that the patents issued during the first six months of 1914 were pending in the office as applications an average time of twenty-one and one-half months. This average has risen until it is now (December, 1914) more than two years. With many of the old applications ultimately eliminated the average time applications pend in the office will be much less than that. Hence a new rule or order requiring all cases which have been pending more than two years and all amendments thereto to be called to the personal attention of the Commissioner may eventually be promulgated.

AMENDMENTS AFTER FINAL REJECTION.

After a case is under final rejection, the following amendments may be entered:

(1) Amendments canceling claims or the matter upon which appeal is to be taken.

(2) Amendments presenting the rejected claims in better form for appeal.

(3) Amendments accompanied by a showing duly verified of good and sufficient reason why they were not earlier presented.

(4) The examiner has discretion to admit other claims for the purpose of appeal.

(5) He can waive the final rejection and open the case for further prosecution.

(6) He can admit amendments containing claims for the purpose of interference.

(7) He can admit an amendment containing a claim which he deems patentable; but the entry of the amendment does not reopen the case for further prosecution.

When broad claims are finally rejected, an amendment canceling the broad claims and substituting more limited claims is not in itself a sufficient showing to reopen the case. Ex parte Lange, 163 O. G., 727 (1911).

In a finally rejected case, the Examiners-in-Chief affirmed the examiner but cited a new reference which disclosed certain features of the claim not shown in the

references of record. This reopened the case for further prosecution before the examiner. Ex parte Wade, 158 O. G., 704 (1910).

Where claims which were recommended by the Examiners-in-Chief are rejected by the examiner on new references, applicant has a right to amend them or substitute new claims therefor, provided they are directed to the same invention as that covered by the rejected claims. If, however, a claim is presented directed to an invention different from the rejected claim, it should not be entered, as the case is not reopened for general prosecution. Ex parte Lindsey, 156 O. G., 1067 (1910).

Where, after a final rejection, an amendment is presented containing some claims which are admissible, such as claims copied from a patent, for instance, and some which are not admissible, the entire amendment should be entered and the requirement made that the claims which are not admissible be canceled before forwarding the appeal. Ex parte Stickney, 185 O. G., 1379 (1912).

After final rejection amendments to the description which do not touch the merits of the claims but present the invention more clearly may be entered without reopening the case for further consideration. Ex parte Loppentien, 122 O. G., 1723 (1906).

If, after final rejection, the examiner requires an amendment to the specification, this does not reopen the case. Final rejection of claims in a case closes the further prosecution not only of the claims under final rejection, but of others substituted therefor. Ex parte Casselman, 116 O. G., 2012 (1905), and Ex parte Novotny, 108 O. G., 1327 (1904).

In a finally rejected case, and in response to an argument, the examiner called attention to a new reference as showing features referred to in the argument. It was held that this citation reopened the case. Ex parte Lawton, 97 O. G., 187 (1901). This decision is based on Rule 68, which states that an applicant "may amend as often as the examiner presents new references or reasons."

No definite rule can be laid down to determine what constitutes a satisfactory showing of reasons why the

amendment was not earlier presented. In determining this question the record of the application should be considered, to see whether the application has been prosecuted in good faith and expeditiously. In Ex parte Schmidt, 171 O. G., 482 (1911), an affidavit was filed by the attorney of record, to the effect that matters contained in the amendment were not earlier presented because of the fact that the inventor had not earlier pointed out to counsel features covered by the proposed amendment. This was held to be a sufficient showing, as the case had been prosecuted in good faith and expeditiously. This case is not inconsistent with Ex parte Schrader, 120 O. G., 2127 (1906), where the petition was denied. There the attorney had filed a statement, stating that the inventor had not called the attention of the attorney to the subject-matter of the proposed claims. The proposed claims were presented to be substituted for the claims finally rejected by the examiner, which rejection was affirmed on appeal by the Examiners-in-Chief and also by the Commissioner.

The excuse that the inventor did not fully explain the subject-matter to the attorney must be carefully considered, as it can be given in almost any case, and if accepted as sufficient, the rule against amending after final rejection would be a nullity.

When a claim is admitted under Rule 68 upon a showing duly verified, the claim must be considered and acted upon by the examiner. He can not hold that it was admitted for appeal only. Ex parte, Meyer, 148 O. G., 1088 (1909).

Where claims are finally rejected and applicant alleges that such claims cover a feature not disclosed in the application, held, that applicant should be permitted to present for appeal claims which unquestionably read upon his disclosure. Ex parte Swanson, 21 Gour., 76-30 (Aug., 1909).

An applicant has no right to amend after decision on appeal except under unusual circumstances and where a proper showing is made. Even then a petition must be made to the Commissioner to reopen the case. Ex parte Auer, 116 O. G., 595 (1905).

AMENDMENT AFTER ALLOWANCE—RULE 78.

Let us follow the course of an amendment under Rule 78, from the time it is filed up to and including its final disposition. After being filed in the Application Division the amendment is sent to the Docket Clerk who then sends to the Issue and Gazette Division for the allowed application file, to which he attaches the proposed amendment, and the notice for the examiner's recommendation, all of which he sends to the examiner. The examiner will recommend that the proposed amendment be entered or not entered as the case may be—usually by endorsement on the proposed amendment—and returns the file with the attached parts, together with his recommendation, to the Docket Clerk, who will transmit it to the Commissioner. If the Commissioner approves the entry of the amendment, the Docket Clerk will immediately send the file and papers to the examiner who will cause the amendment to be entered. The file is then brought back to the Docket Clerk and the applicant or his attorney is notified that the amendment, having been recommended by the examiner, and approved by the Commissioner, has been entered. This letter bears the signature of the Chief Clerk. The Docket Clerk then returns the application to the Issue and Gazette Division. In case the examiner recommends that the amendment be not entered, he will write a letter stating his reasons therefor, and send a copy to the applicant, and return the file, together with the adverse recommendation, to the Docket Clerk, and if the Commissioner approves such adverse recommendation, the Docket Clerk will in like manner notify the applicant or his attorney that the adverse recommendation of the examiner, on the admission of the amendment, a copy of which was sent to him, has been approved by the Commissioner and will return the file to the Issue and Gazette Division.

The examiner is presumed to have jurisdiction of the case until the notice of allowance is sent to applicant. All proper amendments, therefore, received before the notice of allowance is sent, must be received and considered. This is analogous to the practice in interference cases, where the examiner retains jurisdiction of the case until the Examiner of Interferences declares the interference by

forwarding the notices to the several parties to the proceedings. Rules 100 and 102. If an examiner sends a case to issue and thereafter a proper amendment is received, which was filed before notice of allowance is sent, the amendment must be entered and considered. If the notice of allowance is sent, the examiner must withdraw the case from issue and enter and consider the amendment. This is the practice. But if the amendment leaves the case in condition for allowance, no reason is seen why it should not be entered under Rule 78 without withdrawing the case from issue, upon the initiative and recommendation of the examiner, and the approval of the Commissioner. This course would avoid the necessity of withdrawing the case from issue, and of sending a second notice of allowance.

After a case has been sent to issue and the notice of allowance sent, the time for amending, as a matter of right, has expired. The entry of claims under Rule 78 is not a matter of right, but is a privilege granted to applicants after such examination of the case by the examiner as he may deem necessary. Ex parte Goldsmith and Whiting, 184 O. G., 553 (1912).

The admission of amendments under Rule 78 rests largely with the examiner, whose recommendation will not be overruled except under unusual circumstances. It is well settled that an amendment will not be admitted after allowance, where it requires a reexamination of the case. Ex parte Holz, 154 O. G., 1411 (1910).

If the examiner reports that the claims are unpatentable, they will not be entered. Ex parte Langhaar, 159 O. G., 747 (1910). The applicant has no right to appeal from the examiner's decision holding that the claims are unpatentable and therefore the usual reason for explaining fully to the applicant the grounds upon which the conclusion is based does not exist. Ex parte Orndoff, 140 O. G., 1001 (1909). Rule 78 does not provide for prosecution of the case. The examiner has no jurisdiction and his report to the Commissioner is not an action in the case. No hardship or irreparable injury results from the refusal to enter the amendment under Rule 78, as the applicant may allow the application to become forfeited and then file a renewal, or he may abandon

the application in favor of a continuing application, and in this way, secure consideration of the amendment as a matter of right.

The claims in a certain case were finally rejected, appealed to the Examiners-in-Chief, and allowed. The case was passed to issue, and then withdrawn for the purpose of interference. The applicant was defeated in the interference and the claims were rejected under Rule 132. The applicant now presents an amendment canceling the rejected claims and adding new claims. What shall be done with the amendment? The amendment must be entered and considered. The case is not closed before the examiner, although it was closed before the appeal was taken. Withdrawing a case from issue for the purpose of interference reopens the case for further prosecution, and moreover the rejection under Rule 132 is a new ground of rejection. Ex parte Klepetko, 126 O. G., 387 (1907).

AMENDMENTS TO THE PETITION.

The entry of amendments to the petition of an application is governed by Order No. 1874 as modified by Order No. 1994. The petition in an application may be amended to correct names and addresses (other than post-office addresses), and titles of invention. To make a change in the post-office address, a letter signed by the applicant in person and giving his actual post-office address will be accepted. An applicant's post-office address in care of his attorney will not be accepted. Ex parte King, Com. MS. D., Mar. 23, 1900.

AMENDMENT OF THE DRAWINGS.

Where applicant desires to amend a drawing, he should file a photographic print of the original drawing and illustrate on this print or by means of a sketch the change in the original drawing that he desires to make. The print and sketch should then be filed accompanied by a written request for permission to amend the drawing as indicated. The examiner's response to this request should be in writing. Signatures to the drawing may be corrected and reference characters changed by the

office without filing photographic prints if the requirement for such corrections and changes appear in the examiner's letter.

Order No. 2112, of March 30, 1914, directs that—

> Hereafter, corrections and alterations in the disclosure of the drawings of pending applications will be made only by the draftsmen employed by the Patent Office. Inventors, attorneys, and examiners will be guided by this order. The Chief Draftsman will make a reasonable charge for such changes as may be necessary. (See Order No. 1958 of February 3, 1912.)
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> The purpose of this order is to stop the constant mutilation of office records.

EXAMINER'S AMENDMENTS UNDER ORDER 1718.

Where the citizenship of the applicant is given in the oath, but omitted in the preamble to the specification, it may be supplied by examiner's amendment.

In applications otherwise ready for allowance, where the first name of the applicant is disclosed in the record but does not appear in the preamble to the specification, the examiner will insert the first or Christian name of the applicant in the preamble by examiner's amendment.

Examiner's amendments are a great convenience in making minor corrections, but care must be exercised so as not to expand this order to include amendments other than the correction of obvious informalities.

AMENDMENTS CONTAINING NEW MATTER.

The subject of new matter will be presented in another paper, and will not be treated in this paper further than to say that an amendment containing claims to new matter should be entered and rejected for that reason and all other reasons which are deemed applicable. Rice, 21 Gour., 56-22 (June, 1909).

If the amendment attempts to introduce new matter

into the specification but does not present claims for the new matter, the examiner should refuse to enter it. Ex parte Mothes, 113 O. G., 1146; and Ex parte Smith, 58 O. G., 1840 (1892).

If the amendment attempts to introduce new matter into both the specification and the claims, the entire amendment should be entered. The examiner should reject the claims and require the new matter in the specification to be canceled. New drawings, however, should not be entered until the question of new matter is finally determined. Ex parte Furness, 104 O. G., 1655 (1903).

December 10, 1914.